

II. The 35 U.S.C. § 103 Rejections

Claims 57-66, 70-74, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Albal, patent number 5,826,034 (hereinafter *Albal*), in view of Kunigami, patent number 5,508,817 (hereinafter *Kunigami*), and further in view of Berkowitz et al., patent number 5,903,877 (hereinafter *Berkowitz*). Claims 67-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Albal in view of *Kunigami*, further in view of *Berkowitz*, and further in view of Maxwell, patent number 5,805,810 (hereinafter *Maxwell*).

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicants respectfully assert that the references lack proper motivation to combine in addition to lacking all the claim limitations.

Initially Applicants point out that independent claim 57 recites “an intermediate station [including] a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location.” The Examiner concedes that the primary reference Albal does not teach a reproducing circuit producing an indicia of payment authorizing delivery of the human readable information to the select location. However, the Examiner opines that the secondary reference *Kunigami* teaches a system which delivers information to a selected location from a transmitting location, wherein an intermediate station comprises a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the second location.

Applicants respectfully assert that *Kunigami* does not teach or suggest an intermediate location comprising a reproducing circuit adapted to reproduce either information or an

indicia of payment in human readable form. Instead, *Kunigami* expressly teaches both reception and delivery of the messages in electronic form, see column 1, lines 42-46. Accordingly, even if one of ordinary skill in the art were to modify the system disclosed in Albal to include the aspect of *Kunigami* identified by the Examiner, the present invention would not result. Specifically, the resulting combination would not provide an intermediate station comprising a reproducing circuit adapted to reproduce information in human readable form, wherein the reproducing circuit also produces an indicia of payment authorizing delivery of the human readable information to the selected location. The claimed combination would require further unsuggested modifications to the unsuggested modification of the prior art proffered by the Examiner.

In addition to the above distinction, the fee payer identifier of *Kunigami* does not teach or suggest an indicia of payment authorizing delivery of the human readable information as recited in the claim. Directing the Examiner's attention to column 6, lines 38-45, of *Kunigami*, it is expressly taught therein that the receiver selects the mail to be delivered to him by entering a command to receive selected electronic mail and that the electronic mail center only transmits the electronic mail designated by the command. Accordingly, although the fee payer identifier may provide information with respect to who ultimately will pay for electronic mail for which the receiver authorizes delivery, it cannot be said that the fee payer identifier authorizes delivery of the electronic mail.

In contrast to the fee payer identifier of *Kunigami*, a preferred embodiment of the present invention teaches that "output may include not only output of the transmitted document, but may also include output of associated accouterments such as the aforementioned delivery container, delivery instructions (including special delivery instructions, return receipt forms, etc.), indicia of authorization or payment for delivery, such as a postage meter stamp, and the like." It is well known that once a postage meter stamp has been affixed to a postal item that postal item is then fully authorized for delivery by the appropriate postal service, irrespective of whether a recipient desires its delivery or not.

Moreover, it is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. In

opining that it would have been obvious for one of ordinary skill in the art to have performed the modification of Albal in view of *Kunigami* proffered by the Examiner, the Examiner asserts that “Albal’s system would become more efficient and more automated if modified to incorporate *Kunigami*’s teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender.” However, the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Similarly, in providing motivation for the proffered combination of Albal and *Berkowitz*, the Examiner asserts that “Albal’s system would become more versatile with the addition of *Berkowitz*’s converter circuit, as more user’s would be able to send information electronically, wherein the user’s do not have electronic mail capabilities or facsimile machines.” This statement of motivation is also circular and, therefore, a mere statement that the reference can be modified. Accordingly, it is respectfully asserted that a *prima facie* case of obviousness has not been established with respect to the proffered combination of Albal in view of *Kunigami* and in further view of *Berkowitz*.

Moreover, the dependent claims add additional new and non-obvious limitations not found in the art of record. For example, claim 72 recites ancillary information included with the transmitted information, wherein the ancillary information includes a time of transmission of the document which is provided by a secure time piece disposed at the transmitting location. The mention of delivery parameters including the time for delayed delivery provided in Albal at column 9, lines 1-3, and relied upon by the Examiner in rejecting claim 72, does not meet the requirement that the time of transmission is transmitted with the document from the transmitting location.

Additionally, the identified portion of Albal does not fairly teach or suggest the use of a secure time piece. Although the Examiner asserts that the use of a secure time piece is inherent, such a bald assertion is insufficient to establish a proper rejection under either 35 U.S.C. § 102 or 35 U.S.C. § 103. In order to properly establish a rejection based on inherency, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). A reference may not be anticipating under the principle of inherency on the basis of possibilities or probabilities, as anticipation by inherency requires that persons skilled in the art would recognize that the missing material is “necessarily present” in the reference, see *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

The Examiner’s statement that a secured time piece would inherently be used by a workstation does not reasonably support a conclusion that the claimed secure time piece for providing a time of transmission of the document necessarily flows from the disclosure of the prior art. Workstations typically are provided with a non-secure real time clock. Moreover, there is no indication in Albal that the time for delayed delivery is in any way information which should be provided by a secure device. Accordingly, Applicants respectfully assert that the claim is allowable under 35 U.S.C. § 103 over the art of record.

In rejecting claims 68 and 69, the Examiner asserts that *Maxwell* teaches of a funding means which includes at least a value data packet. A review of *Maxwell* reveals that the disclosure teaches that message validator 22 accesses sender database 1300 to locate an account record for the sender, both of which are a part of the netgram workstation which is remotely coupled to the sender (transmission station) through the Internet, see column 4, lines 20-23 and 43-48, and column 5, lines 12-17. It is this netgram workstation which is asserted to provide structure equivalent to the intermediate station recited in the claims. Accordingly, *Maxwell* cannot be fairly read to teach or suggest the transmission of ancillary information including a value data packet for funding the delivery of the information which is transmitted from transmission location.

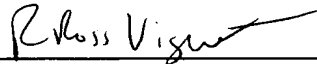
Further with respect to claim 69, the Examiner relies upon the disclosure of *Kunigami* to teach a value deducted from a credit stored at the transmitting location. However, *Kunigami* teaches the preparation of billing information after transmission of the electronic mail based upon the transmission times of the various legs of electronic mail transmission, see e.g., column 7, lines 25-33. In contrast, claim 69 recites value deducted from a credit stored at the transmitting location is communicated as a value data packet included ancillary to the transmitted information. The billing information of *Kunigami*, based upon *a priori* information with respect to the actual transmission times associated with the electronic mail, simply cannot be altered to meet the present claim without unpermissably changing the principle of operation of the prior art invention being modified, M.P.E.P. § 2143.01 citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959).

III. Summary

As shown above, there are great differences between the claims and the prior art. Moreover a person of ordinary skill in the art considering the prior art would not find these differences obvious. Accordingly, Applicant respectfully traverse the Examiner's 35 U.S.C. § 103 rejections. Therefore, Applicant respectfully requests that the claims be passed to issue.

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,



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